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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,185	04/01/2002	Steve Worthington	P67146US0	2831
136	7590	02/24/2006	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			VO, TED T	
			ART UNIT	PAPER NUMBER
			2191	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/926,185	Applicant(s) WORTHINGTON ET AL.	
	Examiner Ted T. Vo	Art Unit 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2 and 3 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/1/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/19/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 11/15/2005.

Claim 2 is withdrawn under restriction/election subject matter. Claim 3 is newly added; but it is also subjected to restriction/election requirement.

Claims 1-3 are pending in this application.

Response to Arguments

2. Applicants' arguments filed within the amendment on 11/15/2005 have fully considered but are not persuasive.

- With regards to the Restriction Requirement, Applicants elected Claim 1 with traverse.

Applicants argued:

Applicant respectfully submits that the Examiner has applied the **wrong standard** in the restriction requirement. Because the present application is a nationalization application of a PCT application filed under 35 U.S.C. 371, the unity of invention standard, rather than the restriction requirement for application under 35 U.S.C. 111, applies (MPEP 1896.1V).

Examiner responds:

This current Application is US patent application. As per Applicants' argument that this Application is filing under National Stage: Applicants are respectfully requested reviewing Chapter 37, all sections,

371	National stage: Commencement.
372	National stage: Requirements and procedure.
373	Improper applicant.
374	Publication of international application: Effect.
375	Patent issued on international application: Effect.
376	Fees.

Particularly, in the section 372 (b)(2), it requires such an application must comply with the section 121 that is applied by this Office action as Restriction/Election requirements.

Art Unit: 2191

- With regards to the arguments to traverse the rejection under 35 U.S.C. 103(a) as being unpatentable over Ahonen et al.

Examiner disagrees:

Fig. 1 shows a process of document assembly. This assembly process aims to create a document (It should be noted that a webpage seen by a web browser is also "document") in which the first formation of the document is the 'document fragments' as shown in the assembly process of Fig. 1. The document (or web pages) is created by browsing and querying a collection of documents. A user plays only a role as tailor; such a tailor would be iterated from a circle of "browsing", "querying", "selection". The end of the assembly process is to provide a complement of the document such as any documents in the Web that we can read. It should be noted that a formal webpage as ready known before the effective filing date of this application is also a document.

Such a process, shown in Fig. 1, also addresses the claim limitation: *means which dynamically create web pages applicable to a document which present document determining queries* (See Fig.1, 'querying') *to the user's browser* (See Fig.1, 'browsing') *and capture decisions made by said user in response* (See Fig.1, 'iteration'), *together with unique user input data relevant only to the particular document being assembled* (See p. 3: line 4, via a WWW user interface).

Would Applicants argue:

"Anonen discloses the use of a single static HTML page to illicit user data which is then submitted to the document assembler. The use of a single static HTML page clearly indicates that Ahonen does not use "means which dynamically create web pages." In addition, the use of a single static HTML page means that there is no genuine interactive assembling of a document as indicated in Claim 1",

to make the term "*dynamically*" in the phrase "*dynamically create web pages*", be patentable?

Examiner finds that the argument for that Ahonen does not use "means which dynamically create web pages" fail to be persuasive. In fact, Ahonen teaches such broad limitations:

means which dynamically create web pages applicable to a document which present document determining queries (See Fig.1, 'querying') *to the user's browser* (See Fig.1, 'browsing') *and capture decisions made by said user in response* (See Fig.1, 'iteration'), *together with unique user input data relevant only to the particular document being assembled* (See p. 3: line 4, via a WWW user interface).

Art Unit: 2191

Furthermore, it is supposed that if the process in the reference is not "dynamic", Applicants fail to discuss in accordance to **1.111(c) and MPEP 714.04**, but Applicants rather utilize common acts of programming technique in order to obtain the same result. The court held that broadly providing an automatic (in this matter: "dynamic") or mechanical means to replace a manual activity (in this matter: Applicants argue that the reference process: "static") which accomplished the same result is **not sufficient to distinguish over the prior art** (emphasis added) (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

For such reasons, the rejection will maintain.

Specification

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use. Cooperation is respectfully requested.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC
(See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)),

Art Unit: 2191

"Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

As addressed in the prior office action, Claim 2 shows as an independent or distinct from Claim 1.

Therefore, the restriction/election requirement is proper.

Claim 1 (group I), a Document Assembly System, and the claim 2 (group II), now including newly added Claim 3 (hereinafter: group II), authorizing software, are distinct. Claim 3 is newly added but appears to be independent type and the same scope as the scope of Claim 2.

Moreover, the newly submitted claim 3 is directed to an invention, "Authorizing software" that is independent or distinct from the invention originally claimed "A document assembly system" (Claim 1) for the following reasons: The scope of Claim 3 is an independent type and the operation mode is clearly the same as Claim 2; thus it is distinct from Claim 1. Since Applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 3 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Art Unit: 2191

This application contains claims 2-3 are drawn to an invention nonelected with traverse in the remarks filed on 11/15/05. A complete reply to the final rejection must include **cancellation** of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahonen et al., "Assembling Documents from Digital Libraries", 1997.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Ahonen discloses, *"A document assembly system resident on a web server which allows a user with web connectivity and a browser to invoke said system and interactively assemble a document at the web server comprising:*

a stored library of packets of text each relating to a different document and each document packet containing blocks of text that will meet a variety of possible contingencies for a document of that type (See page 3, Section 2.1: Structure of the Documents: referring to 'digital library'. See page 7, section 3.1: referring to 'Document fragments', or 'document collections'),

means which dynamically create web pages applicable to a document which present document determining queries to the user's browser and capture decisions made by said user in response, together

Art Unit: 2191

with unique user input data relevant only to the particular document being assembled (See Fig.1,

'browsing', 'tailored document', and see page 3, section 2: System for Tailoring Textbooks via WWW),

means which selects from said library blocks of language based on said user decisions, (See page 4, section 2.2, indentation 1, 'The client fills in an HTML form and submits it.') a database which stores said user data, software that assembles said blocks of language and populates the assembled document with said user data (See page 5, Fig. 3, 'WWW server', 'Technical editor' (database), see page 2, whole Fig. 1, 'Assembly process' (assembled document)),

means for delivering the assembled document to said user".

Ahonen discloses assembling the documents. The delivery shown the Fig. 3 is in the printing manner.

Ahonen does not explicitly disclose delivering the assembled documents to the user in which the documents are part of the document assembly on a web server. However, Ahonen suggests that the documents include SGML/HTML format (page 9), which is the Internet browser readable format. Official notice is taken that delivering documents to a user via web server is well known in the art. Therefore, it would be obvious to a person of ordinary skill in the art at the time of the invention was made to include *assembling the documents in the web readable format*. Thus it could be part of web server delivering, and could deliver to a user by taking advantage of network which requires a standard web language HTML/XML format as transmitted data, the language is designed for Web Browser, and thus it could allow the documents to be transmitted over a network to a user.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

Art Unit: 2191

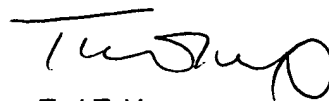
shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ted T. Vo
Primary Examiner
Art Unit 2191
February 8, 2006